

REMARKS:

Claims 1, 3-25, 27-43 and 50-69 are pending in this application. Claims 27 and 37 have been amended for informalities. Claims 56-69 are newly added. It is respectfully submitted that no new matter has been added. Specifically, support for newly added claims 56-69 is found at least at Figures 7a-7b, and page 7, line 23-page 8, line 2, page 8, lines 18-21, page 15, lines 7-11, and page 23, line 14-page 24, line 9, and claims 15, 22 and 38-39, as originally filed.

Claim Objections

Claims 27-28 are objected to as being dependent on a cancelled base claim. Claim 27 has been amended to depend from Claim 25 to address the Examiner's concerns.

Claim Rejections Under 35 U.S.C. 112

Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite because the forming step lacks antecedent basis. Claim 37 has been amended and the rejection is overcome.

Claim Rejections Under 35 U.S.C. 103

Claims 1, 3-25, 27-43 and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent no. 4,550,450 to Kinnett, U.S. patent no. 5,571,203 to Masini, U.S. patent no. 4,042,980 to Swanson et al., and German patent no. DE 1164019 to Chiron-Werke. Applicant respectfully traverses this rejection for the reasons that follow.

In short, it would not have been obvious to one of ordinary skill in the art to combine Masini with Kinnett. The Examiner concedes that his principal reference, Kinnett, does not teach all of the elements of Applicant's invention as set forth in any of the pending claims. The Examiner specifically concedes that Kinnett does not disclose a stabilizing base extension including a plurality of fins. Instead, the Examiner relies upon Masini to teach this feature, and then asserts that it would have been obvious to combine the teachings of Kinnett and Masini. However, it would not have been obvious to combine Masini and Kinnett, because Kinnett relates to a shoulder prosthesis system and Masini relates to hip replacement. Masini simply represents non-analogous prior art. The field of this invention is shoulder arthroplasty and Applicant's claims recite total shoulder arthroplasty apparatuses and methods.

The Examiner has cited column 4, lines 51-53 as providing the required suggestion within the references to render the combination obvious. Those lines do not,

however, provide the required suggestion to combine Kinnett and Masini. Lines 51-53 do not refer to shoulder arthroplasty, and in fact, shoulder arthroplasty is not mentioned anywhere in the '203 patent by Masini as an alternative application of his hip replacement teachings. There is no reason why lines 51-53 should be read to suggest alternative orthopedic devices other than differently-configured hip replacement devices.

The Examiner is respectfully requested to either cite an analogous reference, i.e., one that is in the field of shoulder arthroplasty, or withdraw the rejection of each of Claims 1, 3-25, 27-43 and 50-55.

The Examiner is particularly further referred to dependent Claims 15, 22 and 38-39. These claims recite a template punch (Claims 15 and 22) or insertion of a template punch into the cancellous region of the cut humeral surface prior to coupling the humeral head to the humeral surface (Claims 38-39). As understood, none of the cited references alone or in combination teaches all of the features of any of Claims 15, 22 or 38-39. It is respectfully submitted that each Claims 15, 22 and 38-39 is further allowable for this additional reason.

Newly Added Claims

It is respectfully submitted that newly added claims 56-69 are each allowable. Claim 56 recites an apparatus including a stemless combination of a template punch for coupling to a cut humeral surface and a humeral head for coupling with the cut humeral surface via the template punch, wherein the stemless combination includes a base having a rotationally stable base extension protruding therefrom including one or more fins for impaction into a cancellous region of the cut humeral surface. As understood, none of the cited reference teaches or suggests this advantageous stemless combination. Claims 57-62 are allowable as being dependent from Claim 56. Claim 63 recites a method including preparing a stemless combination of a template punch and a humeral head, the combination including a base extension including one or more fins for efficient rotational stabilization of the combination on a cut humeral surface for coupling with the cut humeral surface; preparing a humeral surface for coupling the combination thereto, including cutting the humeral surface to reveal a cancellous interior; and coupling the combination to the humeral surface including coupling the template punch to the humeral surface and coupling the humeral head to the humeral surface via the template punch. As understood, none of the cited references teaches or suggests this advantageous method including coupling the stemless combination to the humeral surface. Claims 64-69 are allowable as being dependent from Claim 63.

CONCLUSION

In view of the above, it is respectfully submitted that the application is in condition for allowance. The Examiner's reconsideration and further examination are respectfully requested.


A check in the amount of \$42.00 for payment of the additional independent claim is included together with PTO Form no.: PTO/SB/17 (Fee Transmittal for FY 2003).

The Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896. A duplicate page is enclosed.

Respectfully submitted,

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